

## **REMARKS**

This Preliminary Amendment amends the captioned continuation application filed herewith to be substantially identical to its co-pending parent application, U.S. Serial No. 09/384,832, which is presently on after final status. The captioned continuation application has been filed in order to have additional references submitted and considered, which references cannot be considered in the closed prosecution of the parent application. Applicant respectfully requests examination of the present application in view of these new references, which are submitted in an accompanying Information Disclosure Statement (IDS). In addition to this IDS, a separate Declaration by the Applicant is also filed herewith. This additional Declaration concerns the primary basis for rejection for some of the claims in the parent application.

### **I. Amendments**

The foregoing amendments to the drawings, specification and claims only serve to render this application as substantially identical to the co-pending parent application. As in the parent application, Applicant respectfully submits that no new matter is added by these amendments and that the proposed drawing correction, which only modifies a reference character, can be made without requiring a newly submitted redlined sketch.

In particular, Claim 22 has been written to reflect its dependence from Claim 21 as originally intended. In the co-pending parent application Claim 22 is presently dependent upon itself, which error stands objected to in that application. Applicant respectfully submits that Claim 22 as submitted here overcomes this objection. After entry of the foregoing amendments, this modification of Claim 22 is believed to be the only difference between this application and the parent application.

## II. Rejections in the Parent Application

In the co-pending parent application, Claims 1-3, 5-7, 11-13, 15-16, 21, 23-24, and 26-28 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,632,889 issued to Tharp ("Tharp"). In addition, Claims 14 and 18 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Tharp. In particular, the Final Office Action states that "the cartridges (10) are capable of being displaced by fluid, under conditions which would facilitate buoyancy of the cartridges (10), particularly since they are in no way bolted or rigidly fixed to the insert (12)." Applicant respectfully traverses these rejections.

In order to anticipate a claim, a reference must include every material element of that claim. Applicant respectfully maintains that Tharp does not expressly or inherently contain "fluid displaceable adsorbent containers" as presently claimed, such that Tharp does not anticipate or render as obvious any claim presented. In support of this position, Applicant hereby incorporates by reference the remarks presented in Applicant's Response to Office Action of July 18, 2001 in the co-pending parent application, a summation of which is provided in the remarks herein. In addition to the remarks presented herein, Applicant has submitted a separate declaration by Applicant regarding his experience with that which is disclosed in Tharp (also "the '889 patent"). Due to his extensive experience with the Tharp patent and with what is disclosed therein, Applicant is uniquely qualified to testify as to what is inherent to Tharp. Accordingly, Applicant respectfully requests the added consideration of this declaration during the examination of the present continuation application.

Applicant respectfully points out that if a theory of inherency is relied upon to make a rejection, then the examiner must provide a factual or technical basis to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of

the applied prior art. See MPEP § 2112 (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)) (emphasis in original). Similarly, the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)) (emphasis in original). While the statement that “the cartridges [of Tharp] are capable of being displaced by fluid . . . particularly since they are in no way bolted or rigidly fixed to the insert” is not illogical, Applicant respectfully submits that this conclusion is not *necessarily* true, as is required by *Levy*. Applicant thus respectfully resubmits that the foregoing constitutes an insufficient basis for the rejection of these claims due to inherency. Furthermore, as detailed in the accompanying declaration, extensive experience has shown that the cartridges of Tharp in fact do not and have never become displaced by fluid in operation.

Applicant again respectfully submits that Tharp actually teaches away from this proposed inherent feature, such that at the very least it cannot possibly be said that the proposed inherent feature *necessarily* flows from the teachings of Tharp. At column 2 lines 53-60, Tharp states that “[a]t low flow rates, *all* of the incoming water passes through the cartridge 10” (emphasis added), and that “[a]s the flow rates increases [sic], the level of the water in the insert rises until the excess liquid is discharged over the weir 26.” No provision or suggestion is contained within Tharp for any fluid escape route other than by passing through cartridge 10 or over weir 26. In fact, at col. 3 lines 21-22, Tharp states that “A *sealing gasket* 36 prevents water from bypassing the trough [28]” (emphasis added). Fluid would necessarily bypass trough 28 if cartridge 10 floated or otherwise became displaced, thereby rendering this sealing gasket as useless. Hence, the disclosure of a sealing gasket clearly teaches away from adsorbent containers that float or are otherwise fluid displaceable. Furthermore, in considering the disclosure of Tharp in its entirety,

it is apparent that fluid flow is restricted by absorbent material 56 more than any other item, such that fluid passes through holes 22 at the bottom of insert 12 at least as fast as fluid passes through absorbent material 56 and cartridge 10. As a result, there can never be a fluid buildup at the bottom of insert 12 and thus never an opportunity for cartridge 10 to float. As an additional point Applicant further notes that should these cartridges ever become displaced by fluid, that there is nothing to prevent these cartridges from becoming completely dislodged from the system and lost down the drainage system. Nothing in Tharp suggests this as a result, and the vast experience by Applicant has never included an actual instance of a cartridge that has become lost or even displaced in this manner.

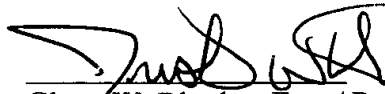
To summarize, Applicant respectfully resubmits that the allegedly inherent characteristic of fluid displaceable adsorbent containers does not *necessarily* flow from the teachings of Tharp, which is a requirement for a theory of inherency. Applicant submits that Tharp teaches away from such a displacement by: 1) disclosing a sealing gasket; 2) stating that all fluid must either pass through its cartridge or pass over its weir; 3) generally describing a system whereby the absorbent material restricts flow more than the bottom of the supporting insert, such that fluid cannot build up at the bottom of the supporting insert; and 4) providing no reference or description to replaceable cartridges due to loss from cartridge displacement and a subsequent flowing downstream in the drainage system. Thus, Tharp teaches sufficiently away from fluid displaceable adsorbent containers such that the proposed inherent feature would defeat the entire spirit and purpose of its disclosure.

## CONCLUSION

Applicant respectfully submits that all claims are in proper form and condition for patentability, and requests a notification of allowance to that effect. Outside the filing fees provided for the entire continuation application filed herewith, it is believed that no other fee is due at this time. Should any fee be required for any reason related to this document, however, the Commissioner is authorized to charge said fee to Deposit Account No. 08-3038, referencing Docket No. 11533.0012.CNUS06. The Examiner is invited to contact the undersigned attorney at (650) 463-8281 with any questions, comments or suggestions relating to this application.

Respectfully Submitted,

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**APPENDIX A—Version with Markings to Show Changes Made**  
**SPECIFICATION SHOWING AMENDMENT OF 02/11/02**

Revised paragraph beginning at page 11 line 3:

Referring to Figures 12-14, another preferred embodiment is illustrated for attaching a support bracket to a frame. Figure 12 illustrates a frame 51 having a first opening 53 and a second opening 55. Referring to Figure 13 [14], a support bracket 57 configured to rest in corresponding openings 53 and 55 is shown wherein a first end 59 of support bracket 57 is inserted into corresponding opening 55. A support bracket mid portion 60 is then inserted into corresponding opening 53. A second end of the support bracket (not shown) may then extend across the filter body and attach to the filter body at strategic locations in order to retain the filter body in the desired shape. A particularly preferred attachment mechanism is illustrated in Figure 14 wherein a support bracket 61 is illustrated having a first end 63 inserted into a corresponding opening in frame 51 and a support bracket mid portion 64 resting in a corresponding opening also in frame 51. An upwardly oriented second end 65 passes through a filter body attachment member (not shown), such as a loop, to assist in retaining the filter body in the desired open position.

**CLAIMS SHOWING AMENDMENT OF 02/11/02**

1. An apparatus, comprising:
  - (a) a filter body dimensioned to fit within an inlet and forming a trough obstructing at least a portion of said inlet;
  - (b) a filter body support dimensioned and adapted to cooperatively engage with said inlet and with said filter body to substantially maintain said filter body in a pre-selected shape and position within said inlet; [and]
  - (c) one or more connectors removably connecting said filter body to said filter body support; and
  - (d) one or more fluid displaceable adsorbent containers within said filter body.
2. The apparatus of Claim 1 wherein said filter body forms a trough along at least a portion of one wall of said inlet.

3. The apparatus of Claim 1 wherein said filter body forms a trough around the perimeter of the inside wall of said inlet.
4. The apparatus of Claim 1 [further comprising one or more] wherein said one or more fluid displaceable adsorbent containers comprise one or more adsorbent pouches removably connected to the interior of said filter body.
5. The apparatus of Claim 1 whereby said one or more fluid displaceable adsorbent containers float as said filter body fills with fluid.
6. The apparatus of Claim 5 whereby said one or more fluid displaceable adsorbent containers float at or near the fluid surface within the filter body.
7. A catch basin filtration system, comprising:  
a filter body dimensioned to fit within an inlet and obstructing at least a portion of said inlet; and  
one or more fluid displaceable adsorbent containers within said filter body.
8. The catch basin filtration system of Claim 7 wherein said one or more fluid displaceable adsorbent containers comprise one or more adsorbent pouches removably connected to the interior of said filter body.
9. The catch basin filtration system of Claim 8 wherein said one or more adsorbent pouches are filled with a removable adsorbent material.
10. The catch basin filtration system of Claim 8 further comprising:  
a filter body support dimensioned and adapted to cooperatively engage with said inlet and with said filter body to substantially maintain said filter body in a pre-selected shape and position within said inlet; and  
one or more connectors removably connecting said filter body to said filter body support,

wherein said filter body forms a trough around the perimeter of an inside wall of said inlet.

11. The catch basin filtration system of Claim 7 wherein said filter body is dimensioned to include a high fluid flow bypass route.
12. The catch basin filtration system of Claim 11 wherein said high fluid flow bypass route comprises an overflow opening at the center of the filtration system.
13. The catch basin filtration system of Claim 7 further comprising:  
one or more filter body support brackets dimensioned and adapted to cooperatively engage with said filter body to substantially maintain said filter body in a pre-selected shape and position within said inlet.
14. The catch basin filtration system of Claim 13 wherein said one or more support brackets are configured to traverse the filter body in an X shape.
15. The catch basin filtration system of Claim 7 wherein said one or more fluid displaceable adsorbent containers are displaced such that debris and sedimentation collects at the bottom of said filter body.
16. A method of separating contaminants from storm runoff, comprising:
  - (a) retaining said runoff in a catch basin filtration system, said system dimensioned to fit within an inlet and forming a trough obstructing at least a portion of said inlet;  
and
  - (b) exposing said runoff to one or more fluid displaceable adsorbent containers within said system.
17. The method of Claim 16 whereby said one or more fluid displaceable adsorbent containers float at or near the fluid surface within the filter body as runoff is processed through said system.



18. The method of Claim 16 further comprising the step of:  
(c) bypassing excess runoff without exposing said runoff to said one or more fluid displaceable adsorbent containers.
19. The method of Claim 16 wherein said one or more fluid displaceable adsorbent containers comprise one or more adsorbent pouches removably connected to the interior of said system.
20. The method of Claim 16 wherein said one or more fluid displaceable adsorbent containers are displaced such that debris and sedimentation collects at the bottom of said system.
21. The method of Claim 16 wherein at least one of said one or more fluid displaceable adsorbent containers attaches to said filter body.
22. The method of Claim 21 wherein at least one of said one or more fluid displaceable adsorbent containers attaches to the interior of said filter body via one or more attaching means selected from the group consisting of clips, snaps, loops and velcro.
23. A catch basin filtration system, comprising:  
(a) a filter body dimensioned to fit within an inlet and forming a trough obstructing at least a portion of said inlet;  
(b) a filter body support dimensioned and adapted to cooperatively engage with said inlet and with said filter body to substantially maintain said filter body in a pre-selected shape and position within said inlet;  
(c) one or more connectors removably connecting said filter body to said filter body support; and  
(d) one or more fluid displaceable adsorbent pouches removably connected to the interior of said filter body, whereby said one or more fluid displaceable adsorbent

pouches float at or near the fluid surface within the filter body as said filter body fills with fluid.

24. The catch basin filtration system of Claim 23 further comprising:

(e) a filter body positioning element situated along at least a portion of the perimeter of the filter body.

25. The catch basin filtration system of Claim 24 wherein said filter body positioning element comprises an inflatable member urged against an inside wall of said inlet and securing said filter body in position.

26. A catch basin filtration system adapted for separating contaminants from storm runoff and dimensioned to fit within a catch basin, said catch basin filtration system comprising one or more fluid displaceable adsorbent containers.

27. The catch basin filtration system of Claim 26 wherein said one or more fluid displaceable adsorbent containers removably attach to the remainder of said catch basin filtration system.

28. A catch basin filtration system, comprising:  
a filter body dimensioned to fit within an inlet and obstructing at least a portion of said inlet; and  
one or more adsorbent containers within said filter body, said one or more adsorbent containers adapted to become displaced as said filter body fills with fluid.